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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/715,074

11/17/2003

Robert J. Beaton

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3295

41081 7590 02/02/2007  
THOMAS SEAN ARMSTRONG  
46806 PLANTERS COURT  
LEXINGTON PARK, MD 20653

EXAMINER

SHRESTHA, KIRAN K

ART UNIT

PAPER NUMBER

2109

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/715,074	<b>Applicant(s)</b> BEATON ET AL.	
	<b>Examiner</b> Kiran K. Shrestha	<b>Art Unit</b> 2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

1. This action is in response to the preliminary amendment filed on November 17, 2003. Claims 1, 12, 23 and 37 are independent claims. Claims 1-41 are pending and have been considered below.

### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### **Content of Specification**

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.

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- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).
- (e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.
- (f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
  - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
  - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (g) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the

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- invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (h) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (i) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (l) Sequence Listing, See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

3. The abstract of the disclosure is objected to because it exceeds 150 words in length. Correction is required. See MPEP § 608.01(b).
4. The disclosure is objected to because of the following informalities: the examiner notes the use of acronyms (e.g. ROM, CD-ROM, etc.) throughout the specification without first including a description in plain text, as required. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 12 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a graphical user interface (GUI), does not reasonably provide enablement for a GUI consisting of history menu. The GUI in this claim consists of a single structural limitation: "A history menu containing menu items", and thus is interpreted as a single means/single step claim under MPEP 2164.08(a).

"A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth

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rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor."

### ***Claim Objections***

7. Claim 14 is objected to because of the following informalities: "A user interface according to claim 12 wherein the or each of said at". It's not clear. It needs to remove "the or" from claim to make clear statement. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-41 are rejected under 35 U.S.C. 102(e) as being anticipated by McEvilly et al. (US2003/0151621A1).

**Claim 1:** McEvilly discloses the method comprising the steps of:

- a) providing at least one menu item being related to a location previously accessed by said end user device (page 3, paragraph [0053]).
- b) receiving selected menu item being one of said at least one menu items relating to a location previously accessed by said end user device (page 3, paragraph [0052]).
- c) retrieving record containing information related to said location (page 3, paragraph [0051]).
- d) accessing said location using information related to said selected menu item (page 3, paragraph [0050]).

**Claim 2:** McEvilly discloses a method as in claim 1 above, and further discloses that the switching a current mode of end user device location to access a mode suitable (page 1, paragraph [0004]).

**Claim 3:** McEvilly discloses a method as in claim 2 above, and further discloses step of switching is accomplished based on information (page 1, paragraph [0004]).



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**Claim 4:** McEvilly discloses a method as in claim 1 above, and further discloses step of launching a software application suitable for use in accessing said location (page 26, paragraph [0322]).

**Claim 5:** McEvilly discloses a method as in claim 4 above, and further discloses steps of (page 18, paragraph [0222]):

- a) establishing a network connection to said location
- b) retrieving content from said location

**Claim 6:** McEvilly discloses a method as in claim 4 above, and further discloses software application is chosen from a group comprising (page 3, paragraph [0052]):

- a) a web browser
- b) an email client
- c) entertainment software
- d) a personal information manager

**Claim 7:** McEvilly discloses a method as in claim 1 above, and further discloses end user device is chosen from a group comprising (page 27, paragraph [0328]):

- a) a mobile telephone
- b) a set top box (STB)
- c) a personal digital assistant (PDA)

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**Claim 8:** McEvilly discloses a method as in claim 1 above, and further discloses the steps of (page 22, paragraph [0271]):

- a) retrieving channel information denoting said location
- b) tuning said end user device to a channel referenced by said channel information

**Claim 9:** McEvilly discloses a method as in claim 8 above, and further discloses location is referenced by channel information (page 22, paragraph [0271]).

**Claim 10:** McEvilly discloses a method as in claim 8 above, and further discloses television channel (page 22, paragraph [0271]).

**Claim 11:** McEvilly discloses a method as in claim 8 above, and further discloses channel schedule (page 22, paragraph [0271]).

**Claim 12:** McEvilly discloses a graphical user interface (GUI) to use in navigating location previously accessed by end user device, the user interface comprising (page 3, paragraph [0053]):

- a) history menu containing menu items

**Claim 13:** McEvilly discloses a GUI as in claim 12 above, and further discloses history menu is only visible to an end user (page 22, paragraph [0271]).

**Claim 14:** McEvilly discloses a GUI as in claim 12 above, and further discloses at least one history item is presented as text history menu (page 15, paragraph [0189]).

**Claim 15:** McEvilly discloses a GUI as in claim 12 above, and further discloses at least one menu item identifies a television channel (page 22, paragraph [0271]).

**Claim 16:** McEvilly discloses a GUI as in claim 12 above, and further discloses at least one menu item identifies a website address (page 25, paragraph [0308 - 0314]).

**Claim 17:** McEvilly discloses a GUI as in claim 12 above, and further discloses at least one menu item identifies a software application (page 27, paragraph [0326]).

**Claim 18:** McEvilly discloses a GUI as in claim 12 above, and further discloses method comprising the steps of:

- a) switching a current mode suitable for accessing said location (page 1, paragraph [0004]).
- b) accessing said location using information related to at least one menu item (page 3, paragraph [0055]).

**Claim 19:** McEvilly discloses a GUI as in claim 18 above, and further discloses launching a software application suitable for use in accessing said location (page 26, paragraph [0322]).

**Claim 20:** McEvilly discloses a GUI as in claim 18 above, and further discloses method comprising the steps of (page 18, paragraph [0222]):

- a) establishing a network connection to said location
- b) retrieving content from said location

**Claim 21:** McEvilly discloses a GUI as in claim 19 above, and further discloses software application is chosen from a group comprising (page 3, paragraph [0052]):

- a) a web browser
- b) an email client
- c) entertainment software
- d) a personal information manager

**Claim 22:** McEvilly discloses a GUI as in claim 18 above, and further discloses retrieving a record associated with an activated menu item (page 17, paragraph [0210]).

**Claim 23:** McEvilly discloses a computer readable media comprising:

- a) providing a history menu containing menu items, at least one menu item being related to a location previously accessed by said end user device (page 3, paragraph [0053]).
- b) receiving an end user input selecting a selected menu item, said selected menu item being one of said at least one menu items relating to a location previously accessed by said end user device (page 3, paragraph [0052]).

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c) retrieving a record associated with said selected menu item, said record containing information related to said location (page 3, paragraph [0051]).

d) accessing said location using information related to said selected menu item (page 3, paragraph [0050]).

**Claim 24:** McEvilly discloses a computer readable media as in claim 23, and further includes switching a current mode of said end user device to a mode suitable for accessing said location (page 1, paragraph [0004]).

**Claim 25:** McEvilly discloses a computer readable media as in claim 24, and further discloses step of switching is accomplished based on said information (page 1, paragraph [0004]).

**Claim 26:** McEvilly discloses a computer readable media as in claim 23, and further comprises the step of launching a software application suitable for use in accessing said location (page 26, paragraph [0322]).

**Claim 27:** McEvilly discloses a computer readable media as in claim 26, and further comprises the step of (page 18, paragraph [0222]):

- a) establishing a network connection to said location
- b) retrieving content from said location

**Claim 28:** McEvilly discloses a method as in claim 1 above, and further discloses that the history menu is not viewable by an end user (page 9, paragraph [0135]).

**Claim 29:** McEvilly discloses a method as in claim 1 above, and further discloses that the history menu has sequential menu items each relating to locations previously accessed by said end user device (page 22, paragraph [0271]).

**Claim 30:** McEvilly discloses a method as in claim 29 above, and further discloses that the history menu is a log of previously accessed locations (page 8, paragraph [0120]).

**Claim 31:** McEvilly discloses a method as in claim 30 above, and further discloses that the end user input selects an immediately preceding item from said log (page 9, paragraph [0134]).

**Claim 32:** McEvilly discloses a method as in claim 29 above, and further discloses that end user input selects an immediately succeeding item from said log (page 15, paragraph [0190]).

**Claim 33:** McEvilly discloses a computer readable media as in claim 23, and further discloses that the history menu has sequential menu items each relating to locations previously accessed by said end user device (page 22, paragraph [0271]).

**Claim 34:** McEville discloses a computer readable media as in claim 33, and further discloses that the history menu is a log of previously accessed locations (page 8, paragraph [0120]).

**Claim 35:** McEville discloses a computer readable media as in claim 33, and further discloses that the end user input selects an immediately preceding item from said log (page 9, paragraph [0134]).

**Claim 36:** McEville discloses a computer readable media as in claim 33, and further discloses that the end user input selects an immediately succeeding item from said log (page 15, paragraph [0190]).

**Claim 37:** McEville discloses a user interface comprising (page 15, paragraph [0189]):

- a) first user activatable control for cycling through items in a log of previously accessed locations in a first direction
- b) second user activatable control for cycling through said items in said log in a second direction
- c) first and second controls interact with said end user device to access locations denoted by said items in said log when one of said first or second controls is activated

**Claim 38:** McEvilly discloses a user interface as in claim 37 above, further discloses that at least one of said items in said log identifies a television address (page 12, paragraph [0161]).

**Claim 39:** McEvilly discloses a user interface as in claim 37 above, further discloses that at least one of said items in said log identifies a website address (page 19, paragraph [0232]).

**Claim 40:** McEvilly discloses a user interface as in claim 37 above, further discloses that at least one of said items in said log identifies a specific software applications (page 23, paragraph [0292]).

**Claim 41:** McEvilly discloses a user interface as in claim 37 above, further discloses that the controls executes a method comprising:

- a) retrieving a record associated with a selected item from said log, said record containing information relating to a location previously accessed by said end user device (page 19, paragraph [0228]).
- b) switching a current mode of said end user device to a mode suitable for accessing said location (page 1, paragraph [0004]).
- c) accessing said location using information (page 22, paragraph [0278]).



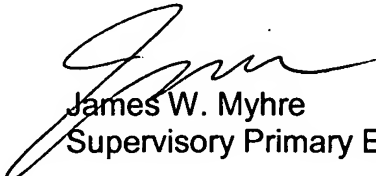
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. Kiran K. Shrestha whose telephone number is (571) 270-1691. The examiner can normally be reached Monday through Thursday from 7:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre, can be reached on (571) 270-1065. The fax phone number for Formal or Official faxes to Technology Center 2100 is (571) 273-3800. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 273-6722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-3600.

K.S.  
KKS  
January 30, 2007

  
James W. Myhre  
Supervisory Primary Examiner